

REMARKS

Claims 62-95 are pending in this application, with original Claims 1-61 cancelled and new Claims 62-95 added. The Applicant respectfully requests reconsideration and review of the application in view of the foregoing amendments and the following remarks.

The Examiner objected to the specification for including an embedded hyperlink and/or other form or browser-executable code. July 12, 2006 Office Action ("Office Action"), page 4. The Applicant, however, has already responded to these objections in the June 7, 2005 response to the Examiner's April 17, 2005 Office Action. Therein, the Applicant, in response to these same objections, amended the specification to delete embedded hyperlinks included on page 10, line 26, page 13, line 17 and page 16, line 4 of the specification. See June 7, 2005 response, pages 2-4 and 19. Therefore, it is respectfully requested that the Examiner withdraw these objections.

The Examiner rejected Claims 10-11 and 25 under 35 U.S.C. § 112, ¶ 1, for failing to comply with the enablement requirement. See Office Action, pages 5-6. The Applicant, however, has already responded to these rejections. Specifically, the Applicant addressed Claims 10-11 in the June 7, 2005 response to the Examiner's April 17, 2005 Office Action. Therein, the Applicant pointed out that Claims 10-11 are sufficiently disclosed in the specification at page 13, line 22 - page 14, line 1 and page 16, line 19- - page 17, line 7. The Applicant further pointed out that the Section 112 rejections of Claims 10-11 were discussed during an interview between the Applicant's representative and the Examiner and that the Examiner agreed to withdraw the rejections. See June 7, 2005 response, page 19.

The Applicant addressed Claim 25 in the December 27, 2004 response to the Examiner's July 6, 2004 Office Action. Therein, the Applicant pointed out that Claim 25 is sufficiently disclosed in the specification at Figure 7, col. 18, line 18 - col. 19, line 4 and col. 20, line 24 - col. 21, line 17. See December 27, 2004 response, page 17. In

the current Office Action, the Examiner states that these pages of the specification “describe the interaction with an already-delivered personal communication, not how the personal communication and its included advertisement are originally formatted.” Office Action, page 5. The Applicant respectfully disagrees. The specification provides, for example, that:

This platform independent architecture not only allows additional communication data to be transmitted to an interacting recipient, it allows data to be provided to a variety of network devices, ***regardless of the request***. The output from the Web site 110 is capable of providing data to a variety of sender network devices and recipient network devices, ***regardless of whether the data is additional communication data, Web page data, or e-mail data***.

Page 21, lines 12-17 (emphasis added). In other words, the platform independent architecture allows both additional communication data *and* e-mail data (e.g., personal communication data) to be formatted for a particular network device. Because Claims 10-11 and 25 are sufficiently disclosed in the specification, and because Claims 10-11 and 25 have been cancelled in lieu of new Claims 62-92, it is respectfully requested that the Examiner withdraw these rejections.

The Examiner rejected Claims 1-61 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach, Jr. et al. (U.S. Pat. No. 6,449,657) in view of Joo et al. (Korean Pat. App. No. 99073076) and Camut et al. (U.S. Pat. No. 6,684,257). The Examiner further rejected Claims 2-4, 41, 45-47, 55 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Joo, Camut and Bayeh et al. (U.S. Pat. No. 6,012,098). The Examiner also rejected Claims 23, 24 and 60 under 35 U.S.C. 103(a) as being unpatentable over Stanbach in view of Joo, Camut and Rakavy et al. (U.S. Pat. No. 6,317,789). These rejections are respectfully traversed.

The primary (and common) references relied upon by the Examiner are Stanbach, Joo and Camut. These references, however, are ***not prior art references*** and therefore ***cannot serve as a basis for a prior art rejection***. The Stanbach, Joo

and Camut references bear dates (i.e., filing or publication dates, collectively referred to herein as "effective cited reference dates") that are only a couple of months earlier than the date the present application was filed (i.e., January 6, 2000). Anthony Rothschild, the inventor of the present invention, conceived of the present invention prior to the effective cited reference dates and was reasonably diligent in reducing his invention to practice. This is supported, for example, by the Declaration of Mr. Rothschild ("Rothschild Decl."), including the exhibits that are attached thereto. Pursuant to 37 C.F.R. § 1.131, a declaration from Mr. Rothschild was submitted to the Examiner, together with Applicant's response, on December 27, 2004.

According to this declaration, Mr. Rothschild disclosed his invention to Jean Paul Schmetz, CEO of Cyber Lab, in April of 1999. Rothschild Decl., ¶¶ 4-10. This is evidenced by the Non-Disclosure Agreement (NDA) signed by Messrs. Rothschild and Schmetz in April 1999 (Exhibit A), the draft proposal from Cyber Lab in May 1999 (Exhibit B), and the detailed proposal from Cyber Lab in August 1999 (Exhibit D). Features that are asserted by the Examiner as being disclosed in the prior art are explicitly discussed in these communications.

For example, independent Claims 62, 68, 75, 81, 87 and 92 are directed toward a system and method of (1) selecting an advertisement, (2) adding the advertisement to a personal communication (e.g., an email), (3) sending the personal communication, including the advertisement to at least one recipient, and (4) compensating the sender and/or recipient for allowing the advertisement to be included in the personal communication. These claimed features were previously discussed in a July 20, 1999 letter from Mr. Rothschild to Christopher Mackenzie, an associate of the private equity investment firm of Clayton, Dublelier & Rice and acquaintance of Martin Sorrel, CEO of WPP, one of the largest advertising agencies in the world. Rothschild Decl., Exhibit C. Therein, it is stated that "[t]he sender can add either automatically or through manual selection, advertising material to the body, top or end of their message or as an attachment to the email." *Id.* In exchange, "[t]he sender receives a certain amount of

benefit or cash for doing this per email.” *Id.*

These features were also discussed in the detailed proposal from Cyber Lab. Rothschild Decl., Exhibit D. Therein, it is stated that “[o]utgoing emails are sent to the @mail server [and] [a]dvertisements are added automatically.” *Id.* It further provides that in one embodiment of the present invention, “[a]ll advertisements which fit into a participant’s field of interests will be assigned to his emails by random selection.” In exchange for doing this, the participants (e.g., the sender and/or recipient) are compensated (e.g., receive “bonus points,” “FreeMail service,” etc.). *Id.*

A cursory review of Mr. Rothschild’s Declaration and the exhibits attached thereto show that Mr. Rothschild conceived of the present invention prior to the effective prior art dates and was reasonably diligent in reducing his invention to practice. Thus, the Stanbach reference (filed August 6, 1999), the Joo reference (published October 5, 1999) and the Camut reference (filed October 15, 1999) are not prior art to the present application and cannot be used as a basis for a rejection. Therefore, because Stanback, Joo and Camut are not prior art, and because Claims 1-61 have been cancelled in lieu of Claims 62-92, it is respectfully requested that the Examiner withdraw these rejections.

In the current Office Action, the Examiner stated that Mr. Rothschild’s Declaration is “insufficient to establish conception of the invention prior to the effective date of the references.” Office Action, page 2. According to the Examiner, “[t]he declaration fails to present facts that the advertisement is adapted to direct the (server’s) advertising application to send the additional communication data to the interacting message recipient,” and “the declaration fails to present facts regarding the determination of a particular device’s required format and the subsequent formatting of the additional communication data consistent with the formatting requirements.” Office Action, pages 2-3. The Applicant respectfully disagrees. For example, the Cyber Lab detailed proposal provides that advertisements may be “dynamic” (e.g., clickable to receive additional advertisement data) and that the additional advertisement data is provided (in

one embodiment of the present invention) via the @mail server, not via the advertiser (e.g., Amazon, BOL, etc.). See, e.g., Rothschild Decl., Exhibit D, block diagrams.

Nonetheless, in an effort to expedite allowance of the present application, the Applicant has cancelled Claims 1-61 and added new Claims 62-95. The new independent claims do not include the limitations objected to by the Examiner (e.g., the advertising application providing additional advertisement data to the recipient and formatting the additional advertisement data for the recipient's network device). In light of the new claims, the Applicant believes that Mr. Rothschild's Declaration is now sufficient to establish conception of the claimed invention prior to the effective dates of the references.

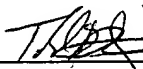
In view of the foregoing amendments and remarks, the Applicant respectfully submits that Claims 62-95 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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The Commissioner is authorized to charge \$695.00 for the accompanying RCE (\$395.), pursuant to 37 C.F.R. §1.17(e), and for the later presentation of three independent claim(s) in excess of three (\$300.), pursuant to 37 C.F.R. § 1.16(h), and any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

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